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EXAMINER

ENG, DAVID Y

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 25

Application Number: 08/887,680
Filing Date: October 11, 1994
Appellant(s): POWELL ET AL.

Raul d. Martinez
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 19, 2003.

(1) R al Party in Int rest

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct except for claims 17-32. The rejection of claims 17-32 under 35 U.S.C. 251 is hereby withdrawn for the reasons set forth below. In summary, claims 1-32 are allowed. Claims 33-38 stand rejected under 35 U.S.C. 251.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct except for claims 17-32. As indicated in section 3 above, the rejection of claims 17-32 has been withdrawn.

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because no supporting statements are provided as to why the claims do not stand or fall together.

Claims 34-38 stand or fall with claim 33.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) *Grounds of Rejection*

The rejection of claims 17-32 under 35 U.S.C. 251 is withdrawn. The reissue claims 1-16 are identical to patented claims 1-16. Reissue claims 17-32 are also identical to patented claims 1-16 except that in reissue claims 17-32 "the least significant bit" instead of "the most significant bit" of the stack pointer register is recited for indicating the word size. The court held that reissue claims that are broader in certain aspects and narrower in others vis-à-vis claims canceled from original application to obtain a patent may avoid the effect of the recapture rule if the claims are broader in a way that does not attempt to reclaim what was surrendered earlier. *Mentor Corp. V. Coloplast, Inc.*, 998 F.2d 992, 27 USPQ2d 1521, 1525 (Fed. Cir. 1993). In this case, paper number 20 of the patented file cancelled claims 55-72 which recited an indication bit in the stack pointer register for indicating the word size in favor of claims 73-88 (renumbered as claims 1-16 in the patent) which recited the most significant bit

Art Unit: 2155

for indicating the word size. The surrendered subject matter therefore is "an indication bit". The scope of the reissue claims 17-32 is narrower than the surrendered subject matter. The rejection of claims 17-32 under 35 U.S.C. 251 is therefore withdrawn.

The following ground(s) of rejection are applicable to the appealed claims:

Claims 33-38 stand rejected under 35 U.S.C. 251. This rejection is set forth in prior Office Action, Paper No. 22 and is incorporated herein by reference thereto.

(11) Response to Argument

In *Clement*, 131 F.3d at 1468-69, 45 USPQ2d at 1164, the Court of Appeals for the Federal Circuit set forth two step test for recapture:

The first step in applying the recapture rule is to determine whether and in what aspect of the reissue claims are broader than the patent claims.

The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter.

When comparing reissue claim 33 to patented claim 1, three aspects of the reissue claim 33 are found different. 1. Reissue claim 33 recites "least significant bit" instead of "most significant bit". 2. Reissue claim 33 does not recite what happened to the stack pointer value in the stack pointer register (the omission of "and transferring a least significant portion of a stack pointer value from the stack pointer register to the first stack save are in memory" in lines 8-9 and lines 12-13 of patented claim 1). 3. Reissue claim 33 does not recite setting a width indication bit in the first stack save area in memory (line 11 of claim 1) such that the width indication bit in the first stack save area

Art Unit: 2155

in memory indicates that the data values for the procedure have the second word size (lines 14-16 of claim 1).

With respect to the first aspect, there is no recapture for the same reasons set forth in the withdrawal above. The reissue claim 33 is neither narrower nor broader than the patented claim 1. Rather, reissue claim 33 is of the same scope in this aspect.

With respect to the second and the third aspects, reissue claim 33 is broader than patented claim 1. The first Clement rule therefore is satisfied. The only remaining issues are (a) what have been surrendered during prosecution of patent application 08/321,459, and (b) whether the broader aspects of the reissue claims are related to the subject matter surrendered.

(a) What were surrendered.

In paper number 17 of application 08/321,459, Appellants cancelled claims 55-72 in favor of claims 73-88 in response to the previous Examiner's prior art rejections of claims 55-72 (paper number 14 and 16) (claims 73-88 of the patented file is renumber as claims 1-16 when 08/321,459 was issued as patent). The prosecution history of 08/321,459 indicates that the subject matters of the second and the third aspects were surrendered respectively by Appellants' cancellation of claims 55-72 in paper number 17 and the cancellation of claims 33-54 in paper number 8.

(b) Whether the broader aspects of the reissue claims are related to the subject matter.

Art Unit: 2155

Reissue claim 33 does not recite 1. what happened to the stack pointer value in the stack pointer register, 2. setting a width indication bit in the first stack save area in memory such that the width indication bit in the first stack save area in memory indicates that the data values for the procedure have the second word size.

From the above, it is clear that Appellants try to recapture what were surrendered when claims 33-54 were cancelled by paper number 8 and when claims 55-72 were cancelled by paper 20. It is therefore respectfully requested that the rejection of claims 33-38 under 35 U.S.C. 251 be sustained.

Respectfully submitted.



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Conferee:



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